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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,638

04/28/2006

Ryoji Hanada

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24978 7590 05/12/2010

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

05/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,638	Applicant(s) HANADA ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claims 10-12 require that the continuous portion is "curved radially outward between the pair of holding surfaces". Support for this is however only found in the description of the embodiment depicted in fig. 2. Claim 1 however is restricted to the embodiments that are described as having a divided holding surface of 5-30% width (i.e. figs. 3 and 4). There is no original description of an embodiment with divided holding surfaces that also has a curved continuous portions as required by claims 10-12. This is therefore subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is new matter.

3. Claims 1 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With the addition of new dependent claims 10-12 that seem to be intended to read on the fig. 2 embodiment, the scope of what is meant by the requirement for

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divided holding surfaces in claim 1 is now indefinite and confusing. In other words, since claim 1 is apparently intended to read on the fig. 2 embodiment (by virtue of the addition of new claims 10-12), whereas it would not appear that present claim 1 is generic to that embodiment, the scope of the claim 1 requirement for divided holding surfaces cannot be readily ascertained. It is stressed that the fig. 2 embodiment was not described as having divided holding surfaces and in fact was specifically distinguished from the fig. 3 embodiment on this grounds (not esp. that the main distinguishing feature of the fig. 3 (and fig. 4) embodiment was that the holding surface is divided in the width direction).

In claim 1, lines 11-14 as amended, it is not clear if the claim is explicitly requiring a step of swelling of the belt/tread assembly radially outward with the reducing of the space between bead supporting members. In particular, this claim language seems to only define this swelling as a capability of the transfer apparatus upon expansion of the carcass (i.e. "allows...") rather than actually positively defining these features as steps. As it seems that these may be intended to be positive steps in the method, an ambiguity is raised.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 2420329 to Continental taken in view of Nebout (US 3,151,013 - newly cited) and optionally at least one of [Garver (US 3,923,572 - newly cited) and Menell (US 3,687,757 - newly cited)].

DE '329 is applied for substantially the same reasons as set forth in the last office action. As to the new language with respect to specifics of the carcass shaping, DE

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'329 does not detail the specific manner of shaping the carcass. Forming a primary green tire carcass using a drum including a pair of bead supporting members that are moved inward (i.e. the space therebetween is reduced) to toroidally shape the carcass for joinder with the belt/tread is a well known, typical and obvious tire assembly procedure in this art - Nebout (note bead supporting members 41) is exemplary (note also bead supporting members 14/15 in Garver and "6" in Menell) - only the expected and predictable results would have been achieved in adopting such a well known procedure. As to the outward swell of the belt/tread assembly, as already noted, it is not clear that the claim explicitly requires this as a positive step, it being again noted that the transfer ring in DE '329 would provide a capability to swell as claimed. In any event, it is also noted that it would have been obvious to provide for a small degree of swell upon contact with the carcass in view of Garver and/or Menell. In particular, Garver suggests that giving the tread a small concavity by pressure from the underlying carcass contacting the tread center facilitates subsequent stitching of the tread to the carcass - note esp. figs. 4-5 and col. 3, lines 57-60 - while Menell suggests that a small swell enhances belt cord paths (e.g. figs. 1-2 and related description). A method as required by claim 1 as amended would therefore have been obvious.

As to claims 10-11, the segments 34 and holding surfaces 35 will be curved radially outward in the circumferential direction. As to claim 12, the holding parts 35 are protruded. As to claim 13, the parts 34 are straight in the widthwise direction. As to claims 14-15, the surface of parts "35" is spaced from the segments 34 towards the tire. To provide some curvature to these seals to match and thereby improve sealing to the

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tread would have been obvious and lead to only the expected results, it being readily apparent that a longer sealing surface will provide a better seal.

5. Applicant's arguments filed 1/13/2010 have been fully considered but they are not persuasive, at least as regards the remaining rejection. The rejection based upon GB '722 has however been withdrawn as being less relevant than the applied prior art to the claims as amended.

As to the rejection based upon DE '329, applicant stresses the suction cups of figs. 3-5. Figs. 3-5 are however believed to represent an alternative embodiment to the relevant fig. 2 embodiment. It is also argued that the swell shown in fig. 2 of DE '329 "appears to be the natural shape of the tread and 8 and not a swell." This argument has been carefully considered but is unpersuasive. It is not the examiner's position that fig. 2 of DE '329 shows a swell of the tread. Rather, it was/is the examiner's position that the holding/transfer device holds the tread such that a center portion thereof is "allowed to swell". In any event, to the extent that the new language is read to require an actual positive step of swelling, note the statement of rejection above and especially the new citation of Garver and Menell.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/
Primary Examiner, Art Unit 1791

G. Knable
May 10, 2010